



2829

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Yuen-Foo Michael Kou

Art Unit : 2829

Serial No. : 09/924,279

Examiner : Paresh H. Patel

Filed : August 8, 2001

Title : METHOD AND APPARATUS FOR EVALUATING A SET OF ELECTRONIC COMPONENTS

Commissioner for Patents  
Washington, D.C. 202314/ Ekt  
G. S. Singh  
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TECHNOLOGY CENTER 2829

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RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Office Action mailed March 26, 2003 Applicant traverses the assertion made in the Office Action that FIGS. 1, 2A, 2B, 4, 6A, and 6B each show patentably distinct species of the claimed invention.

First, Applicant asserts that FIGS. 1, 6A and 6B are not patentably distinct species. Applicant points out that FIGS. 6A and 6B are not patentably distinct species because they are linked to each other by virtue of the circle attached to the diamond, numbered 544 in FIG. 6B. Accordingly, Applicant asserts that FIG. 6A and 6B, considered together, detail one single method to evaluate a set of electronic components. The fact that this method was divided into two figures does not support the conclusion that two patentably distinct species exist. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement as to FIGS. 6A and 6B.

Furthermore, Applicant asserts that the method illustrated by FIGS. 6A and 6B is not patentably distinct from the method illustrated in FIG. 1. Specifically, FIG. 1 includes block 106, specifying the step: "evaluate suitability for installation" of a set of electronic components. As pointed out above, FIGS. 6A and 6B provide particular details of a method to evaluate suitability for installation of a set of electronic components. Since FIGS. 6A and 6B essentially detail a

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Amy V. Armitage

particular step illustrated in the method of FIG. 1, they should not be considered patentably distinct from the method of FIG. 1.

Applicant further points out that, because the methods of FIG. 1, 6A and 6B are related in design, operation and effect, there would be no undue burden on the U.S. Patent Office to examine all of the claims that read on these figures together. Applicant further asserts that method claims 7 – 25 and article claims 58 - 64 read on FIGS. 1, 6A and 6B. Applicant respectfully requests withdrawal of the restriction requirement as to FIG. 1, 6A and 6B.

Second, Applicant asserts that FIGS. 2A and 2B are not patentably distinct species from each other. FIGS. 2A and 2B merely illustrate system block diagrams of alternative hardware configurations to embody the inventive concepts described in the application. Applicant points out, page 7 of the specification, lines 16 – 21, which reads, “[t]he processor 208 [of FIG. 2A] can perform local processing of data. Alternatively, the environmental condition recorder 202 [of FIG. 2A] can transfer collected data to the remote device 214 for processing. As shown in FIG. 2B, the functionality of the remote device’s processor 218 and memory storage unit 220 could be incorporated into the local processor 208A and the memory storage unit 210A of the environmental condition recorder 202A.” (Emphasis added). This broad language highlights the fact that FIGS. 2A and 2B merely illustrate two possible hardware configurations to implement the inventive concepts and not two patentably distinct species of an invention. The fact that an inventive concept may be implemented in more than one hardware configuration does not support the conclusion that there is necessarily more than one patentably distinct species.

In the present case, Applicant respectfully asserts that because the implementations illustrated in FIG. 2A and 2B are related in design, operation and effect, there would be no undue burden on the U.S. Patent Office to examine the hardware claims that read on both configurations. Applicant also points out that FIGS. 3A, 3B, 3C, 3D and 3E represent actual physical embodiments of the block system diagrams of FIGS. 2A and 2B. Moreover, Applicant asserts that hardware claims 26 – 57 read on FIGS. 2A, 2B, 3A, 3B, 3C, 3D and 3E and respectfully requests withdrawal of the restriction requirement as to FIG. 2A and 2B.

Third, Applicant observes that the Office Action seems to be implicitly requiring restriction between method/article claims 7 – 25 and 58 – 64 on the one hand, and hardware type

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claims 26 – 57 on the other hand. If this is the case, Applicant respectfully requests that such a restriction be made explicit.


To be fully responsive, Applicant provisionally elects the species of FIG. 6B, upon which claims 7 – 25 and 58 – 64, read.

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Respectfully submitted,

Date: \_\_\_\_\_

April 22, 2003



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